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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): OBERMAIER, Hannsjorg

Confirmation No.: 7605

Application No.: 09/390,824

Examiner: FIGUEROA, Felix

Filing Date: Sept. 7, 1999

Group Art Unit: 2833

Title: Printed Circuit Card Carrier for Longitudinal On-line Replacement

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on Feb. 12, 2004. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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Date: April 12, 2004

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Date: April 12, 2004



Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Dear Sir:

Appellant notes with appreciation that the Examiner entered the Amendment After Final received in the Patent Office on October 8, 2003.

The Examiner's Answer contains a new assertion that Appellant argues against the references individually, contrary to the requirements of *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Furthermore, while referencing a particular portion of Cranston III, et al. as providing the specific suggestion to combine references, the Examiner's Answer misrepresents the point of Appellant's arguments.

I. Appellant's Discussion of Both References Did Not Amount to Attacking the References Individually

The Examiner's answer (on page 8) asserts that Appellant individually attacks the references, contrary to *In re Keller* and *In re Merck & Co.* The referenced text of *In re Keller* pertains to whether a given element must be shown in a single reference, or whether it need only be shown in the cited combination of references (*see, In re Keller*, 642 F.2d 413, at 427). The referenced text of *In re Merck & Co.* pertains to whether a reference teaches away from an invention in isolation, or whether it teaches away in light of the prior art taken as a whole (*see, In re Merck & Co.*, 800 F.2d 1091, at 1097). Neither of these points are applicable to the present case.

5 In Appellant's brief, Appellant is establishing that the cited art fails to provide a suggestion to combine the cited references. Rather than simply asserting that a single reference did not disclose the suggestion, Appellant reviewed the disclosure of the cited art as a whole, arguing that neither reference contained a suggestion to combine the references when viewed as a whole.

10 II. Cranston III, et al., Considered in Light of the Cited Art as a Whole Fails to Provide a Suggestion to Combine the Cited References

On pages 5 and 8, the Examiner's Answer alleges that the suggestion to combine is contained in the following statement: "Depending upon the particular accessory circuit board 71, an external connection means 73 is provided to electrically connect at least accessory circuit board 71 with components external to computer 1" (*see, Cranston III, et*
15 *al.*, col. 4, lines 58-62). This statement simply recognizes that common vertically inserted cards have bulkheads providing external connections when vertically inserted in motherboards configured for vertical insertion.

As recited in M.P.E.P. 2141, a basic consideration that applies to obviousness
20 rejections is that the references must be considered as a whole, and must suggest the desirability and thus the obviousness of making the combination. Indeed, as noted in another of the cases cited in the Examiner's Answer, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art. . . ." *See, In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).

25 As noted in Appellant's Brief, Cranston III, et al. pertains to a card cage that contains both a planar circuit board that includes a CPU (i.e., a motherboard), and various accessory boards that plug into the motherboard. This card cage was created because "[c]hanges in CPU and support technologies often necessitate replacement of the mother
30 board or planar circuit board along with the CPU" (*see, Cranston III, et al.*, col. 2, lines 4-6).

In contrast, Moss relates to a carrier assembly (100) used to mount expansion cards (28) on a motherboard (30) (*see, Moss*, col. 2, line 45, to col. 3, line 24). It is designed to
35 protect and align an expansion card during insertion and removal of the card from the

motherboard of a live chassis (*see*, Moss, col. 1, lines 31-39). This is relevant not because Appellant has claimed (or failed to claim) insertion and removal from a live computer (as suggested on pg. 9 of the Examiner's Answer), but rather because it further supports Appellant's contention that the alleged suggestion to combine is not applicable to the combination of these references.

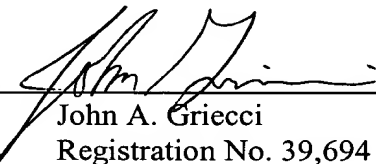
More particularly, the Moss device is intended to create a connection to a live motherboard, whereas the Cranston III, et al. device is effectively an insertable computer in and of itself. There is no suggestion in Cranston III, et al. to arbitrarily use features from an insertable computer to augment an existing card carrier. Thus, when these references are considered as a whole, they fail to provide a suggestion to combine the cited references to form the claimed invention. The attempt to combine features from these entirely distinct devices amounts to nothing more than hindsight reconstruction, picking and choosing among isolated disclosures in the prior art.

III. Conclusion

In light of the above, it will be appreciated that the Examiner's points of argument fail to overcome the deficiencies in the Examiner's original rejection of claims. For the reasons stated in Appellants' Brief, supplemented by the reasons set forth above, the § 103(a) rejections are improper and should be reversed. A decision directing the Examiner to issue a Notice of Allowance is respectfully requested.

Respectfully submitted,

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